

REMARKS

Claims 1-80 are pending in the present application, with claims 1, 18, 23, 26, 57, 75 and 80 being independent. No claims have been amended by way of this response.

Statement of the Substance of the Interview/Withdrawal of Finality of Office Action

Applicant appreciates the courtesies extended to Applicant's representative, Matthew T. Shanley, during the personal interview conducted on August 19, 2005. During the interview, Applicant's representative and Examiner Ke discussed the Examiner's interpretation of the Glenn reference and its relationship to claim 1 of the present application. Specifically, Applicant's representative submitted that the Examiner's interpretation of the Glenn reference was improper.

In the Final Office Action dated May 5, 2005, the Examiner at page 2 clearly indicated:

Glenn et al. ("Glenn") teaches a communications method for transferring electronic data between users of a communications system, the method comprising: upon opening of the electronic message by the recipient, indicating an online state of one or more of the sender and any other recipient of the electronic message (see Glenn, paragraphs 0021 and 0022). Glenn does not teach delivering an e-mail from a sender to at least one recipient and the electronic message as an e-mail message.

However, Applicant's representative discussed with the Examiner that paragraphs 0021 and 0022 of the Glenn reference do not appear to teach or suggest the features identified by the Examiner. The Examiner indicated that he would need to review the Glenn reference in further detail to determine if other areas of the Glenn reference teach or suggest the features previously identified by the Examiner as being present in the Glenn reference. Specifically, the Examiner's position is that other sections of the Glenn reference, i.e., sections not identified in the Final Office Action with respect to the independent claims, may teach the feature identified by the Examiner.

As stated at the conclusion of the interview, Applicant respectfully submits that the Final Office Action dated May 5, 2005 is improper and should be withdrawn. Specifically, section 706.07 of the MPEP describes the propriety of making a Final Rejection:

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. *They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.*

In the present case, the Examiner has suggested that other portions of the Glenn reference may teach the features of claim 1 identified by the Examiner. Further, the Examiner appeared to admit during the interview that paragraphs 0021 and 0022 do not teach the features of claim 1 previously suggested by the Examiner. In order to properly respond to the Examiner's grounds of rejections, the corresponding method or structure in the prior art must be correctly identified by the Examiner. Applicant cannot reasonably be expected to respond to an interpretation of the prior art of record that has not yet been made a part of the official record. Accordingly, if the present application is not allowed after consideration of this response, Applicant respectfully submits that the finality of the previously issued office action must be withdrawn.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-4, 6-9, 11-68 and 71-80 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Glenn (U.S. Patent Application Publication No. US200210021307) in view of Kudoh (U.S. Patent No. 5,948,058), and further in view of Schindler (U.S. Patent No. 6,081,830). Claim 5 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Glenn in view of Kudoh , and further in view of Schindler and Bezos (U.S. Patent No. 6,525,747). Claim 10 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Glenn in view of Kudoh,

and further in view of Schindler and Bunney (U.S. Patent No. 6,446,112). Claims 69 and 70 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Glenn in view of Kudoh, and further in view of Schindler and Alexander (U.S. Patent No. 6,640,230). These rejections are respectfully traversed.

In order to be responsive to the Final Office Action, Applicant submits that the prior art of record fails to teach or suggest each and every limitation of the unique combination of limitations recited in the claims. However, as stated above in Applicant's Statement of the Substance of the Interview, the Examiner's stated grounds of rejection fail to establish a proper prima facie case of obviousness.

With respect to claims 1, 18 and 23, Applicant submits that the prior art of record fails to teach or suggest each and every feature of the unique combination of features recited in the claims. For example, the prior art of record does not teach or suggest the feature of "*upon opening of the e-mail message by the recipient, indicating an online state of one or more of the sender and any one other recipient of the e-mail message,*" as recited in claims 1, 18 and 23. (Emphasis added.) Accordingly, the rejection of claims 1, 18 and 23, and their dependent claims, is traversed.

With respect to claim 26, the prior art of record fails to teach or suggest the feature of "*indicating means for *indicating an online state* of at least one of the sender and any one other recipient of the e-mail message upon opening of the e-mail message by the recipient.*" (Emphasis added.) Accordingly, the rejection of claim 26, and its dependent claims, is traversed.

With respect to claims 57, 75 and 80, the prior art of record fails to teach or suggest the feature of "*after receipt of the e-mail message by the recipient, indicating an online state of one or more of the sender and any one other recipient of the e-mail message,*" as recited in claims 57, 75 and 80 and their dependent claims. (Emphasis added.) Accordingly, the rejections of claims 57, 75 and 90, and their dependent claims, is traversed.

Independent claims 1, 18, 23 and 26 recite a method (claim 1), a program (claim 18), and an apparatus (claims 23 and 26) for transferring electronic data between users of a

communications system that includes, among other features, first delivering an e-mail message from a sender to at least one recipient and, upon opening of the e-mail message by the recipient, indicating an online state of one or more of the sender and any other recipient of the email message. The online state of the one or more of the sender and any other recipient of the email message lets the at least one recipient know the online status of the sender and any other recipient of the email. Similarly, claims 57, 75 and 80 recite a method (claim 57), a program (claim 75) and an apparatus (claim 80) for indicating an online state of one or more of the sender and any one other recipient of an e-mail message, after receipt of the e-mail message by the recipient.

In contrast, Glenn describes a method and apparatus for first using online presence information that indicates the status of intended recipients of a message. The user (sender) determines how to send a message only *after* the online presence information of an intended recipient is determined and reviewed by the sender. See Glenn at Abstract and Glenn at paragraphs 0056-0062. In rejecting independent claims 1, 18, 23, and 26, the Office Action specifically relies upon Glenn, citing paragraphs 0021 and 0022 of Glenn, which are reproduced below:

[0021] The information retained by the presence engine is communicated to each client device in a binary fashion. When the client device receives the binary information it displays a presence indicator. The presence indicator is a cue that provides users with a way to determine what other users are connected to the network (e.g. a visual, audio, or video cue).

[0022] In one embodiment of the invention, the presence indicator is a graphic that is displayed on a web page. The graphic has multiple states and is associated with a particular user. The graphic is designed to communicate the status of the user with which the graphic is associated. In one state, the graphic indicates that a particular user is connected to the interconnection fabric. In a second state, the graphic indicates that the same user is not using the network. The presence indicator may also be an audio or video cue configured to communicate the states discussed above.

Neither the relied upon portion, nor any other portion, of Glenn describes or suggests indicating the online state of an electronic message sender or recipient. Instead, Glenn generally

discloses a presence discovery process that is employed in advance of (and is otherwise unrelated to) message sending. More specifically, according to Glenn, a first network user must initially transmit a message to a central presence engine to indicate the connectivity status of that user. See Glenn, paragraph 0067. Thereafter, when a second network user wishes to discover the connectivity status of the first user, the second user must query the presence engine which, in response, transmits a presence indicator displaying the connectivity status associated with the first user. See Glenn, paragraphs 0064 and 0067. Once the connectivity status of the first network user is transmitted from the presence engine to the second user, that second user may send to the first user a message (e.g., an e-mail) or an instantaneous communication (e.g., an instant message) based upon the connectivity status of the first user. See Glenn, paragraphs 0056 and 0059. Glenn or Kudoh fail to teach or suggest the unique sequence of sending an electronic message first, and indicating the online state of an electronic message sender or recipient within the message.

While the Glenn process involves providing a message sender with information regarding the online status of a potential recipient, it does not involve providing a recipient of a message presence indicators within messages that have been sent and received. Accordingly, neither the relied upon portion, nor any other portion, of Glenn describes or suggests indicating the online state of a sender and/or recipient(s) upon the opening of an electronic message by the recipient.

Furthermore, the Examiner has indicated that the first and second network users of Glenn are a potential recipient and a sender of a potential message, respectively, but fails to disclose provision of online status indicator(s) for the sender and any other recipient of a message that has been sent in accordance with the independent claims. Specific embodiments in Glenn directed at an auction site or presence information embedded in a document, e.g., such as an HTML or .GIF document, all require the same functionality that is different than the unique sequences of events recited in the claims. In the auction example of FIG. 3 of Glenn, an initiating user (a sender) first receives presence information about a receiving user (a recipient). The user (sender) then determines how best to send information concerning an auction to the receiving user (recipient). In FIG. 4 of Glenn, an embedded document having presence information (downloaded from a

server by the sender) about a potential receiving user (recipient) is provided to a potential initiating user (sender).

In every embodiment described or suggested by Glenn, the following sequence of steps are inherently required by Glenn:

1. A presence indicator is generated with information about the potential recipient.
2. Presence information concerning the online state of the potential recipient is displayed for the sender.
3. A communication interface is provided for the sender that determines the proper protocol for sending the message to the recipient based on their predetermined on-line state.
4. Either an instantaneous message (such as an instant message protocol) or a queued message (such as an email stored in a server for later delivery when the recipient is actually present) is sent only after presence information is considered by the sender.

In contrast, as recited in the claims, the electronic message is first sent and the information concerning the on-line state of the sender of the message is displayed for the recipient of the message. The recipient of a message in the Glenn reference never receives information about the online state of the sender of the message. Therefore, Glenn and the remaining references of the prior art of record fail to teach or suggest this unique functionality in part, or in combination. As such, any resulting combination of the prior art of record also would fail to teach or suggest each and every limitation recited in the claims, and the Examiner has failed to establish a proper prima facie case of obviousness. Accordingly, these rejections must be withdrawn.

Kudoh describes an e-mail cataloging and retrieving system to facilitate the classification of numerous e-mails with minimal time and effort. See Kudoh, Abstract and col. 3, lines 30-35. Although Kudoh teaches delivery of an e-mail from a sender to at least one recipient, Kudoh is not relied upon to remedy the shortcomings of Glenn, which are discussed above, and fails to do so. Specifically, Kudoh does not remedy the failure, by Glenn, to describe or suggest (1) indicating the online state of one or more of the sender and any other recipient of an electronic message and (2) indicating such an online state upon opening of the electronic message by the

recipient, as recited in independent claims 1, 18, 23, and 26. The Examiner has suggested that Glenn fails to discuss the use of e-mails and has therefore relied upon the alleged teachings of Kudoh to overcome this shortcoming. Although Glenn's discussion of the use of e-mails is unrelated to the claimed subject matter or any problem associated with the claimed subject matter, Glenn does discuss the use of e-mails (in the same paragraph 0022 referenced by the Examiner in the Final Office Action). Therefore, if the Examiner properly considers the entirety of Glenn's teachings, the Examiner will realize that e-mails are described by Glenn in a manner that is in direct contrast to the modification advanced by the Examiner. Specifically, the Examiner's suggested modification of the Glenn reference to include features that were intentionally avoided by Glenn is an improper hindsight reconstruction of the claimed subject matter. Accordingly, the rejections based upon the alleged combination of Glenn in view of Kudoh are improper and should be withdrawn.

With respect to Schindler, the Examiner has indicated that this reference teaches a method of indicating the online state of the sender and every other recipient of the chat room. Schindler still fails to cure the deficiencies cited hereinabove with respect to Glenn and/or Kudoh. In Schindler, the online state of the sender and every other recipient of a chat room is not sent until presence information is actually reviewed by the sender. Presence information indicating the online state of *a recipient* must be reviewed (and online state confirmed) before Schindler permits the sender to send a message. Accordingly, Schindler does not cure the deficiencies of the alleged combination of Glenn and Kudoh to reveal the presence information of a sender to the recipient.

Accordingly, Applicant respectfully asserts that the prior art references relied upon by the Examiner fail to teach or suggest all of the claim limitations recited by independent claims 1, 18, 23, 26, 57, 75 and 80. For this reason, *inter alia*, Applicant asserts that a *prima facie* case of obviousness has not been established with regard to the independent claims. Applicant therefore respectfully requests reconsideration and withdrawal of the §103(a) rejection of independent claims, and their respective dependent claims 2-17, 19-22, 24-25, 27-56, 58-74 and 76-79.

Claim 5 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Glenn in view of Kudoh and further in view of Schindler and Bezos (6,525,747). As discussed above with respect to the independent claims, Glenn, Kudoh and Schindler, either alone or in combination, fail to describe or teach the features of independent claim 1. Bezos does not remedy the failure of Glenn, Kudoh and Schindler. For at least this reason, and based on its dependency from independent claim 1, Applicant respectfully requests withdrawal of the rejection of claim 5.

Claim 10 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Glenn in view of Kudoh, and further in view of Schindler and Bunney (6,446,112). As discussed above with respect to independent claim 1, Glenn, Kudoh and Schindler, either alone or in combination, fail to describe or teach the features of the independent claims. Bunney does not remedy the failure of Glenn, Kudoh and Schindler. For at least this reason, and based on its dependency from independent claim 1, Applicant respectfully requests withdrawal of the rejection of claim 10.

Claims 69 and 70 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Glenn in view of Kudoh, and further in view of Schindler and Alexander (U.S. Patent No. 6,640,230). As discussed above with respect to independent claims 57, Glenn, Kudoh and Schindler, either alone or in combination, fail to describe or teach the features of the independent claims. Alexander does not remedy the failure of Glenn, Kudoh and Schindler. For at least this reason, and based on their dependency from independent claim 57, Applicant respectfully requests withdrawal of the rejection of claims 69 and 70.

Applicant submits that all of the claims are in condition for allowance.

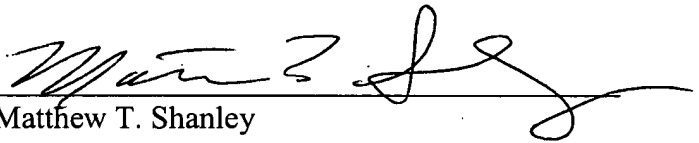
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The period for response was extended on September 6, 2005 with the timely filing and payment of the appropriate extension of time and a Notice of Appeal. Accordingly, no further extensions of time are required in connection with this response. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: September 9, 2005


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